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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/464,866	12/16/1999	RICHARD BRYAN SAGAR	PHA-23.884	8189

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PHILIPS ELECTRONICS NORTH AMERICA CORPORATION
CORPORATE INTELLECTUAL PROPERTY
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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT

PAPER NUMBER

2684

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/464,866

Applicant(s)

SAGAR, RICHARD BRYAN

Examiner

Stephen M. D'Agosta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Alley et al. U.S. Patent 5,845,282 further in view of Nishino U.S. Patent 6,233,452 and ***Microsoft Windows*** (hereafter referred to as Alley, Nishino and ***Microsoft***).

As per **claim 1**, Alley teaches a method of selecting and retrieving computer data files from a remote computer (abstract) [eg. transferring information in a first database of a first electronic apparatus to a second apparatus], **but is silent on** comprises:

- uploading the information from the first apparatus to a server – the information stored in a first database of the first apparatus for use in the first apparatus,
- ***determining whether the information is more recent than a copy of the information stored on the server***
- ***updating the copy of the information with the uploaded information, if it is determined that the uploaded information is more recent***
- manipulating the information at the server; and
- downloading the manipulated information from the server to the second apparatus for storage in a second data base of the second apparatus for use in the second apparatus.
- wherein the manipulated information can be automatically entered into the second database for use by an application in the second apparatus requiring a predetermined data format regardless of communication compatibility between the first apparatus and the second apparatus.

Alley does teach a separate "software module", resident on the remote computer, that acts as a separate server [C2, L31-34 – ref "server program"] (eg. and the server accessible by a second apparatus) where data is sent to, translated as needed and sent to the pen-based computer (C2, L63-67 to C3, L1-10). Today, both software programs and servers can be logically co-located and/or distributed without a marked difference to

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system operation and performance. The examiner also points out that Alley allows for modifications to his invention (C14, L6-18) which provides for a design in which the "software module" is not co-located with the remote computer but rather located on a separate (physical) server.

Having now shown that Alley can be modified to have a separate, intermediate server, the invention can perform the following functions:

- uploading the information from the first apparatus to a server, the information stored in a first database of the first apparatus for use in the first apparatus (C2, L19-44),
 - manipulating the information at the server (C2, L43-44); and
 - downloading the manipulated information from the server to the second apparatus for storage in a second data base of the second apparatus for use in the second apparatus (C2, L19-44).
- wherein the manipulated information can be automatically entered into the second database for use by an application in the second apparatus requiring a predetermined data format regardless of communication compatibility between the first apparatus and the second apparatus. Alley teaches a pen-based PDA that can download data (eg. Calendar application data) from a stand-alone PC's database into the PDA application (C2, L7-9 and figure 3 shows a calendar application on the LCD screen, #152 and #158).

Nishino teaches a wireless information processing terminal and controlling method (title) whereby a user can access the Internet and download information from a web server (abstract). This thus teaches an intermediate server (eg. the web server) that has had information uploaded to it from a first apparatus to allow a second apparatus to download said information for use.

Microsoft teaches the MY BRIEFCASE application which provides synchronization of files between a portable computer and a main computer/server (the information below was found in Microsoft Windows by clicking on START, then HELP and then doing a search on MY BRIEFCASE and then select DISPLAY and then select TO SYNCHRONIZE FILES ON CONNECTED COMPUTERS):

To synchronize files on connected computers

1. On your portable computer, copy files from shared folders on your main computer to My Briefcase. (You can drag the files to the My Briefcase icon on your desktop.)

2. Work on your files on your portable or laptop computer. It can be disconnected from the main computer.

3. When you have finished working on the files, connect the two computers, and then double-click the My Briefcase icon.

4. On the Briefcase menu, click Update All.

Or, click the files you want to update, and then click Update Selection.

Note: When you are copying files from your main computer into My Briefcase, the two computers must be connected, either over a network or by a cable.

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It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that (**updated**) information is uploaded to a server from a first apparatus and then downloaded to a second apparatus, to allow the (**updated**) information to be sent to an intermediate server so that only one server/program is required to serve data which reduces the number of servers/programs which need to be setup (also provides for secondary, offsite backup of data).

As per **claim 2**, Alley teaches the method of 1, wherein a user utilizing a pen-based hand-held computer can connect to a remote computer and download data to the hand-held for storage (abstract and/or C2, L19-29). Alley shows the connection phase (figure 10a), the display of various directories and files on the remote computer (figure 10B) and the selection of a specific file on the remote computer (figure 10C).

Alley also discusses the trend whereby personal organizers are gaining popularity and can perform functions such as keeping a calendar, address book, to-do list, etc. (C1, L20-30). Hence, the examiner assumes that both the hand-held and remote computer can have at least a first and second communications functionalities and a first and second database (eg. the first apparatus has a first communications functionalities using data stored in first data base AND the second apparatus has a second communications functionalities using data stored in second database – the applicant teaches the NinoTM while Alley teaches the Apple NewtonTM which can store a database and communications preferences such as phone numbers and modem/IR parameters (C1, L31-38 and figure 1 shows PCMCIA and IR interfaces [C6, L32-62]). Alley specifically states that directories can be accessed/downloaded (figure 10B) and that these directories can relate to many different purposes (eg. the first data base relates to a first communications directory AND the second data base relates to a second communications directory – note that Alley and the applicant's databases store similar data [ref. applicant's specification page 2, Lines 18-20]).

Lastly, Alley discusses data downloads in a "generic" sense and therefore the examiner interprets that any data which is capable of being stored in the remote computer can be downloaded to the hand-held computer without restriction.

As per **claim 3**, Alley teaches the method of claim 1, wherein each of the first and second apparatus comprises at least one of the following: a PDA (C4, L47-50) and a pager (C6, L40), **but is silent on** a PDA with an Internet capability, a mobile phone and a wired phone.

Nishino teaches a wireless/wired phone (C1, L6-8 and figure 1), Internet connectivity by the device(s) [C3, L22-24) and a PDA (C1, L11).

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that a wireless/wired phone and Internet connectivity are supported, to allow for multiple portable/stationary devices to be used and to allow for Internet connectivity which provides cheaper access costs (eg. local call to ISP) and worldwide connectivity.

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As per **claim 4**, Alley teaches the method of claim 1, **but is silent on** wherein the information is uploaded via the Internet from the first apparatus to the server.

Nishino teaches a wireless information processing terminal and controlling method (title) whereby a user can access the Internet and download information from a web server (abstract). This thus teaches an intermediate server (eg. the web server) that has had information uploaded to it from a first apparatus to allow a second apparatus to download said information for use.

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that information can be uploaded via the Internet, to provide for cheaper access costs (eg. local call to ISP) and worldwide access.

As per **claim 5**, Alley teaches the method of claim 1, **but is silent on** wherein the information is downloaded via the Internet to the second apparatus.

Nishino teaches a wireless information processing terminal and controlling method (title) whereby a user can access the Internet and download information from a web server (abstract). This thus teaches an intermediate server (eg. the web server) that has had information uploaded to it from a first apparatus to allow a second apparatus to download said information for use.

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that information can be downloaded via the Internet, to provide for cheaper access costs (eg. local call to ISP) and worldwide access.

As per **claim 6**, Alley teaches the method of claim 1, **but is silent on** wherein the server keeps a copy of the information uploaded.

Nishino teaches a wireless information processing terminal and controlling method (title) whereby a user can access the Internet and download information from a web server (abstract). This thus teaches an intermediate server (eg. the web server) that has had information uploaded to it from a first apparatus to allow a second apparatus to download said information for use. Web servers are typically "read-only" and do not allow a user to delete or change the stored content, hence the server will keep a copy of the uploaded information until changed by someone with admin privileges.

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that the server keeps a copy of the information uploaded, to allow for the information to be used many times without being deleted (or until the user contacts an administrator asking them to upload new information) and/or for use as secondary/backup/offsite storage.

As per **claim 7**, Alley teaches the method of claim 1, wherein the manipulating comprises converting the format of the data (C3, L7-10) and the ability of selectively extracting data from the uploaded information (C10, L24-34 – Alley allows for many different functions to be performed. Thus "selectively extracting data" is a function that would be apparent to one skilled in the art).

As per **claim 8**, Alley teaches a method of a method of selecting and retrieving computer data files from a remote computer (abstract) [eg. providing a service for enabling to transfer information in a first database of a first electronic apparatus to a second apparatus],

but is silent on comprises:

- enabling to upload the information from the first apparatus to a server, the information stored in a first database of the first apparatus for use in the first apparatus
- ***enabling to determine whether the information is more recent than a copy of the information stored on the server***
- ***updating the copy of the information with the uploaded information, if it is determined that the uploaded information is more recent***
- enabling to manipulate the information at the server;
- enabling to download the manipulated information from the server to the second apparatus for storage in a second data base of the second apparatus for use in the second apparatus
- wherein the manipulated information can be automatically entered into the second database for use by an application in the second apparatus requiring a predetermined data format regardless of communication compatibility between the first apparatus and the second apparatus.

Alley does teach a separate "software module", resident on the remote computer, that acts as a separate server [C2, L31-34 – ref "server program"] (eg. the server accessible by a second apparatus – C2, L31-44) where data is sent to, translated as needed and sent to the pen-based computer (C2, L63-67 to C3, L1-10). Today, both software programs and servers can be logically co-located and/or distributed without a marked difference to system operation and performance. The examiner also points out that Alley allows for modifications to his invention (C14, L6-18) which provides for a design in which the "software module" is not co-located with the remote computer but rather located on a separate (physical) server.

Having now shown that Alley can be modified to have a separate, intermediate server, the invention can perform the following functions:

- enabling to upload the information from the first apparatus to a server, the information stored in a first database of the first apparatus for use in the first apparatus (C2, L19-44),
- enabling to manipulate the information at the server (C2, L43-44);
- enabling to download the manipulated information from the server to the second apparatus for storage in a second data base of the second apparatus for use in the second apparatus (C2, L19-44)
- wherein the manipulated information can be automatically entered into the second database for use by an application in the second apparatus requiring a predetermined data format regardless of communication compatibility between the first apparatus and the second apparatus. Alley teaches a pen-based PDA that can download data (eg. Calendar application data) from a stand-alone PC's database into

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the PDA application (C2, L7-9 and figure 3 shows a calendar application on the LCD screen, #152 and #158).

Nishino teaches a wireless information processing terminal and controlling method (title) whereby a user can access the Internet and download information from a web server (abstract). This thus teaches an intermediate server (eg. the web server) that has had information uploaded to it from a first apparatus to allow a second apparatus to download said information for use.

Microsoft teaches the MY BRIEFCASE application which provides synchronization of files between a portable computer and a main computer/server (the information below was found in Microsoft Windows by clicking on START, then HELP and then doing a search on MY BRIEFCASE and then select DISPLAY and then select TO SYNCHRONIZE FILES ON CONNECTED COMPUTERS):

To synchronize files on connected computers

1. On your portable computer, copy files from shared folders on your main computer to My Briefcase. (You can drag the files to the My Briefcase icon on your desktop.)

2. Work on your files on your portable or laptop computer. It can be disconnected from the main computer.

3. When you have finished working on the files, connect the two computers, and then double-click the My Briefcase icon.

4. On the Briefcase menu, click Update All.

Or, click the files you want to update, and then click Update Selection.

Note: When you are copying files from your main computer into My Briefcase, the two computers must be connected, either over a network or by a cable.

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that (***updated***) information is uploaded to a server from a first apparatus and then downloaded to a second apparatus, to allow the (***updated***) information to be sent to an intermediate server so that only one server/program is required to serve data which reduces the number of servers/programs which need to be setup (also provides for secondary, offsite backup of data).

As per **claim 9**, Alley teaches the method of claim 8, wherein the enabling to manipulate comprises converting of a format (C3, L7-10) and the ability of selectively extracting data from the information (C10, L24-34 – Alley allows for many different functions to be performed. Thus “selectively extracting data” is a function that would be apparent to one skilled in the art).

As per **claim 10**, Alley teaches the method of 8, wherein a user utilizing a pen-based hand-held computer can connect to a remote computer and download data to the hand-held for storage (abstract and/or C2, L19-29). Alley shows the connection phase (figure 10a), the display of various directories and files on the remote computer (figure 10B) and the selection of a specific file on the remote computer (figure 10C).

Alley also discusses the trend whereby personal organizers are gaining popularity and can perform functions such as keeping a calendar, address book, to-do list, etc. (C1, L20-30). Hence, the examiner assumes that both the hand-held and remote computer can have at least a first and second communications capability and a first and second database (eg. the first apparatus performs first communications functionalities using data stored in the first data base AND the second apparatus performs second communications functionalities using data stored in the second database – the applicant teaches the NinoTM while Alley teaches the Apple NewtonTM which can store a database and communications preferences such as phone numbers and modem/IR parameters (C1, L31-38 and figure 1 shows PCMCIA and IR interfaces [C6, L32-62]). Alley specifically states that directories can be accessed/downloaded (figure 10B) and that these directories can relate to many different purposes (eg. the first data base relates to a first communications directory AND the second data base relates to a second communications directory – note that Alley and the applicant's databases store similar data [ref. applicant's specification page 2, Lines 18-20]).

Lastly, Alley discusses data downloads in a "generic" sense and therefore the examiner interprets that any data which is capable of being stored in the remote computer can be downloaded to the hand-held computer without restriction.

As per **claim 11**, Alley teaches a method for transferring data in a database of a Pen based mobile terminal (eg. first mobile terminal) to a PC/laptop (figure 4) [eg. second mobile terminal], comprising a method for transferring data from a first computer system with a first operating system to a second computer system running a second operating system (via a communications link) whereby files are translated by a server program and uploaded/downloaded (C2, L19-4)

[eg - providing a common server accessible to a first mobile terminal and a second mobile terminal, the first mobile terminal having at least a first application and associated first database for use in the first mobile terminal, and the second mobile terminal having at least a second application and associated second database for use in the second mobile terminal;

- retrieving and uploading data from the first application's first database to the common server
- converting the uploaded data to conform to a user of the second application and associated second database
- downloading the converted data automatically into the second database for use by the second application].

- associating the data with a particular user (C10, L38-57 discloses logging into a computer which identifies a specific user and allows access only to their files)

- determining a format required by the particular user (C9, L64-67 to C10, L1-23 discloses connection between machines via protocol(s) and C10, L24-37 teaches file/format translation).

But is silent on a separate server and the mobility of both terminals.

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Alley does teach a PDA which can have a wireless link (IR is disclosed – C6, L40-45) and Alley also discloses a PC, laptop or notebook (C1, L13-19) which can have wireless LAN adapters.

Alley does teach a separate “software module”, resident on the remote computer, that acts as a separate server [C2, L31-34 – ref “server program”] (eg. and the server accessible by a second apparatus) where data is sent to, translated as needed and sent to the pen-based computer (C2, L63-67 to C3, L1-10). Today, both software programs and servers can be logically co-located and/or distributed without a marked difference to system operation and performance. The examiner also points out that Alley allows for modifications to his invention (C14, L6-18) which provides for a design in which the “software module” is not co-located with the remote computer but rather located on a separate (physical) server.

Nishino teaches a wireless information processing terminal and controlling method (title) whereby a user can access the Internet and download information from a web server (abstract). This thus teaches an intermediate server (eg. the web server) that has had information uploaded to it from a first apparatus to allow a second apparatus to download said information for use.

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that information is uploaded to a server from a first apparatus and then downloaded to a second apparatus, to allow the information to be sent to an intermediate server so that only one server/program is required to serve data which reduces the number of servers/programs which need to be setup (also provides for secondary, offsite backup of data).

As per **claim 12**, Alley teaches the method of claim 11 wherein the first database includes data from a Calendar and/or Personal Information Manager (C2, L6-9) which would include a telephone directory.

As per **claim 13**, Alley teaches the method of claim 11 wherein the second database includes data from a Calendar and/or Personal Information Manager (C2, L6-9) which would include a telephone directory.

As per **claim 14**, Alley teaches the method of claim 11 wherein the first apparatus and the second apparatus includes one or more of a PDA (C1, L32-38) **but silent on** a pager and a cellular phone.

Nishino teaches a PDA, Personal Handyphone (eg. cell phone) and to a “wireless information processing terminal” (eg. pager, etc.) [C1, L6-15].

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that communications with a cell phone and/or pager is possible, in order to transfer data easily between the PDA and these wireless devices which can store large amounts of data as well.

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As per **claim 15**, Alley teaches the method of claim 1, wherein the manipulated information includes data from a Calendar or Personal Information Manager [C2, L6-9] (eg. one or more telephone numbers) **but is silent on** automatically retrievable by the second apparatus to initiate a telephone call from the second apparatus.

Alley teaches a user-operated system in that it is fully manual. Many programs today have been automated to remove the need for user interaction, especially for mundane tasks such as updating/synchronizing files. Well known automated programs such as Microsoft Outlook and Briefcase provide automatic synchronization of data files so that the user does not have to either remember to check for new email (Outlook) and/or upload changes made during the day (Briefcase). Alley teaches a Calendar program that is a program under the Microsoft umbrella and would be an excellent reason as to why automatic updates would be obvious (eg. the user roams all day and inputs data to the Calendar or PIM program. Late in the day the user's desktop PC initiates a call to the PDA for data download/synchronization).

It would have been obvious to one skilled in the art at the time of the invention to modify Alley, such that data is automatically retrievable by the second apparatus to initiate a telephone call from the second apparatus, to provide automated downloads/synchronization that don't require user intervention and always keeps data up-to-date.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Hunter can be reached on 703-308-6732. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist on telephone 703-206-0377.

SMD
December 18, 2002


WILLIAM CUMMING
PRIMARY EXAMINER
GROUP 2600